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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,142	11/03/2003	Gary E. Jenkins	JENK / 02A	3727

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WOOD, HERRON & EVANS, LLP
2700 CAREW TOWER
441 VINE STREET
CINCINNATI, OH 45202

EXAMINER

CHAN, SING P

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 04/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/700,142	Applicant(s) JENKINS ET AL.	
	Examiner Sing P. Chan	Art Unit 1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
 4a) Of the above claim(s) 19-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>02/12/04</u> . | 6) <input type="checkbox"/> Other: ____ |

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DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-18, drawn to an apparatus for applying a printed label, classified in class 156, subclass 540.
 - II. Claims 19-26, drawn to a method for applying a printed label, classified in class 156, subclass 277.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as applying and sealing carton with tape.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, the search required for Group I is not required for Group II, and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
4. During a telephone conversation between Examiner Jerry A Lorengo and Mr. David H. Brinkman on December 8, 2004 a provisional election was made with traverse

to prosecute the invention of group I, claims 1-18. Affirmation of this election must be made by applicant in replying to this Office action. Claims 19-26 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11-17 of U.S. Patent No. 6,672,356 in view of Soto et al (U.S. 6,615,106). The claims of U.S. Patent No. 6,672,356 recite an apparatus for applying a printed label. The apparatus includes a

label printer, a label applicator mechanism operatively connected with the label printer for receiving a label printed by said label printer and transporting the printed label toward one side of the loaded pallet for applying the printed label thereto at a predetermined label position which is variably definable for individual loaded pallets independent of pallet size, a drive mechanism capable of moving the label applicator mechanism relative to the loaded pallet, a programmable control operatively coupled to the drive mechanism and capable of receiving data defining the predetermined label position, the programmable control, in response to receiving the label position data, causing the drive mechanism to move the label applicator mechanism to apply the printed label to one side of the loaded pallet at the predetermined label position, the programmable control includes a controller capable of receiving the label position data from a remote data source, the drive mechanism is capable of moving the label applicator mechanism to a plurality of different positions so as to applying the printed label to one side of the loaded pallet at any one of a plurality of predetermined label positions which are variably definable for the loaded pallet, a carriage assembly mounted for movement on a support member, wherein the label applicator mechanism is mounted on the carriage assembly, the label printer is mounted on the carriage assembly, the drive mechanism includes an elongated rack mounted on the carriage assembly and capable of engaging the rack, and a drive mechanism includes a motor, and the pinion is operatively connected to an output of the motor. (See claims 11-17 of U.S. Patent No. 6,672,356) '356 does not recite a rotatable applicator arm with a label applicator head mounted on the applicator arm and rotation of the arm by the rotary

actuator assembly rotate the printed label toward one side of the loaded pallet.

However, providing a rotatable applicator arm with a label applicator head mounted on the applicator arm and rotation of the arm by the rotary actuator assembly rotate the printed label toward one side of the loaded pallet is well known and conventional as shown for example by Soto et al. Soto et al discloses a label applying apparatus. The apparatus includes a rotatable applicator arm with a label applicator head mounted on the applicator arm and rotation of the arm by the rotary actuator assembly rotate the printed label toward one side of the loaded pallet. (Col 6, lines 33-52)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a rotatable applicator arm with a label applicator head mounted on the applicator arm and rotation of the arm by the rotary actuator assembly rotate the printed label toward one side of the loaded pallet as disclosed by Soto et al in the apparatus of '356 to provide an apparatus capable of applying two separate labels to two mutually perpendicular surfaces of the package, box, or carton. (See Soto et al, Col 2, lines 46-50)

Specification

8. The abstract of the disclosure is objected to because the abstract is more than 150 words. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-6, 8, 10-15, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Franklin et al (U.S. 5,865,918).

Regarding claims 1, 4-6, 10, and 13-15, Franklin et al discloses an apparatus for applying a printed label. The apparatus includes a label printer or printers for printing more than one labels (Col 14, lines 20-21), a label applicator, slides and rotary actuator for moving and controlling the label applicator (Col 14, lines 24-26) to apply label to either side of boxes (Col 11, lines 43-51), a computer system for controlling and operating the apparatus with a touch screen for programming label location on a product. (Col 14, lines 27-31)

Regarding claims 2, 3, 11, and 12, Franklin et al discloses the applicator includes a lever arm with a pad on one end for carrying the label during the rotation toward one side of the box (Col 11, lines 61 to Col 12, line 21) and a rotary actuator for rotating the applicator. (Col 14, lines 24-26)

Regarding claims 8 and 17, Franklin et al discloses the rotary actuator is a commercially available actuator such as a rack and pinion type on a slide or carriage assembly and is capable of engaging the rack. (Col 12, lines 23-24)

Claim Rejections - 35 USC § 103

11. Claims 7 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franklin et al (U.S. 5,865,918) as applied to claims 6 and 15 above, and further in view of Carpenter et al (U.S. 5,232,539).

Franklin et al as disclosed above is silent as to the printer is mounted on the carriage assembly. However, mounting the label printer on the carriage assembly is well known and conventional as shown for example by Carpenter et al. Carpenter et al discloses an apparatus for label object. The apparatus includes a movable printer on the carriage assembly for movement to proper height and for applying the label. (Col 3, lines 45-54)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a movable printer on the carriage assembly for movement to proper height or position as disclosed by Carpenter et al in the apparatus of Franklin et al to reduce the time between the application of labels. (See Carpenter et al, Col 1, lines 44-50)

12. Claims 9 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franklin et al (U.S. 5,865,918) as applied to claims 8 and 17 above, and further in view of Schwenke et al (U.S. 5,940,293).

Franklin et al as discloses the slides with pinion. (Col 14, lines 24-26 and Figure 21) Franklin also shows in Figure 21, a motor is operatively connected to the pinion. In any event, operatively connects a motor to a pinion on a slide is well known and conventional as shown for example by Schwenke et al. Schwenke et al discloses an industrial controller for bar chart editing. The apparatus includes moving the components with induction motors, hydraulic, or pneumatic cylinders, which are all equivalents. (Col 7, lines 10-23)

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide motor, hydraulic, or pneumatic cylinders operatively connected to pinion on a slide as disclosed by Schwenke et al in the apparatus of Franklin et al, which are all equivalents.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sing P. Chan whose telephone number is 571-272-1225. The examiner can normally be reached on Monday-Friday 7:30AM-11:00AM and 12:00PM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A. Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chan Sing P
spc

CA Fiorilla
CHRIS FIORILLA
SUPERVISORY PATENT EXAMINER
Au 1734